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MAILED  
FROM DIRECTOR'S OFFICE

MAR 27 2008

In re Application of: Steven C. ROBERTSON  
Application No. 09/324,601  
Filed: June 2, 1999  
For: SYSTEM AND METHOD FOR  
PROVIDING ELECTRONIC MULTI-  
MERCHANT GIFT CERTIFICATE &  
CONTRIBUTION BROKERING  
SERVICES OVER A DISTRIBUTED  
NETWORK

TECHNOLOGY CENTER 3600

**DECISION ON PETITION  
TO RECONSIDER PETITION  
FILED UNDER  
37 CFR 1.198**

This decision is in response to the petition filed on January 17, 2008 entitled "Request for Reconsideration of Petition filed under 37 CFR 1.198".

The petition is DENIED.

File History

The Board of Patent Appeals and Interferences (hereafter: "BPAI") mailed a first "Decision on Appeal" (hereafter: "First Decision") on August 20, 2007. The First Decision sustained the rejection of claims 23-37 under 35 USC 102(e) as anticipated by Gillin. No claims stood allowed.

Appellant, in response to the First Decision, filed a "Request for Rehearing" (hereafter: "Request for Rehearing") as well as a "Petition under 37 CFR 1.198" (hereafter: "First Petition"). The Request for Rehearing and the First Petition were filed, concurrently, on October 19, 2007. The First Petition was accompanied by a proposed amendment to claims 23, and 29-35.

A "Decision on Petition to Reopen Prosecution after Board Decision under 37 CFR 1.198" (hereafter: "Decision on Petition") was mailed December 5, 2007. The Decision on Petition held the First Petition as being dismissed because the First Petition was considered premature inasmuch as it was filed prior to the decision on appeal having become final for judicial review.

The BPAI mailed a second "Decision on Appeal" (hereafter: "Second Decision") on January 16, 2008. The Second Decision again sustained the rejection of claims 23-37 under 35 USC 102(e) as anticipated by Gillin. No claims stood allowed.

Appellant filed a "Request for Reconsideration of Petition under 37 CFR 1.198" (hereafter: "Instant Petition") on January 17, 2008.

The Instant Petition

It is noted that the Instant Petition has been filed subsequent to the Second Decision (the former having been filed on January 17, 2008 and the latter having been mailed on January 16, 2008). It is further noted that the Decision on Petition stated:

*"[A] petition under 37 CFR 1.198 may be resubmitted, without prejudice, following a decision on the Request for Rehearing by the BPAI."*

The Instant Petition, however, is not considered to be a resubmission of the Petition under 37 CFR 1.198 as advised in the Decision on Petition. Rather, the Instant Petition is considered to be a petition seeking reconsideration of the dismissal of the First Petition based upon a holding that the First Petition was filed prematurely.

In the Instant Petition, petitioner argues:

"Applicant believes that "a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review," as required by 37 CFR 1.198, regardless of having filed a request for rehearing, because Applicant has received a decision from the Board of Patent Appeals and Interferences (hereafter Board) dated Aug. 20, 2007."  
(emphasis added)

"The only requirement mentioned is that no court action [has] been filed and in the present case none has been filed."

The Decision on Petition stated the following:

*"37 CFR 1.198 states:*

*'When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.'* (emphasis added)

*Inasmuch as the Request awaits consideration by the BPAI, the Decision is not considered to have become final for judicial review--and, a petition under 37 CFR 1.198 is considered premature until such time."*

As noted above, Appellant had filed the Request for Rehearing on October 19, 2007. Appellant also, concurrently, filed the First Petition on October 19, 2007. At the time of the filing of the First

Petition, the BPAI had not rendered its Second Decision (the Second Decision having been mailed only as of January 16, 2008).

37 CFR 41.52(a)(1) identifies when a decision on appeal is considered final for judicial review when Appellant has filed a request for rehearing (as is the case here).

37 CFR 41.52(a)(1) states (in pertinent part):

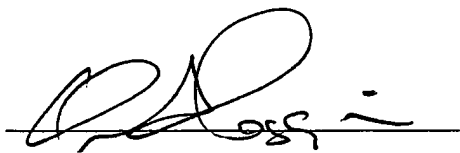
“When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.” (emphasis added)

Accordingly, the decision on appeal became final for judicial review as of the date of the rendering of the decision on the Request for Rehearing (i.e. as of January 16, 2008--the mail date of the Second Decision). In this case, any petition filed under 37 CFR 1.198 and prior to January 16, 2008 is premature and properly dismissed as such because the decision on appeal had not been final for judicial review until January 16, 2008.

#### Summary

The Instant Petition is DENIED.

Telephone inquiries should be directed to Jeffrey A. Smith, Supervisory Patent Examiner, at (571) 272-6763.



Wynn Coggins, Director  
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(571) 272-5350

WC/jas: 03/4/2008

*R*